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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/827,741	04/06/2001	Vivek Amir Jairazbhoy	10541/277	6704

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EXAMINER

DUONG, THO V

ART UNIT PAPER NUMBER

3743

DATE MAILED: 12/31/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)
	09/827,741	JAIRAZBHOY ET AL.
	Examiner Tho v Duong	Art Unit 3743

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) Responsive to communication(s) filed on 22 October 2002.

2a) This action is **FINAL**. 2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) Claim(s) 1-21 is/are pending in the application.

4a) Of the above claim(s) 5,7-9,12-15 and 21 is/are withdrawn from consideration.

5) Claim(s) _____ is/are allowed.

6) Claim(s) 1-4,6,10,11 and 16-20 is/are rejected.

7) Claim(s) _____ is/are objected to.

8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.

 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) The proposed drawing correction filed on _____ is: a) approved b) disapproved by the Examiner.

 If approved, corrected drawings are required in reply to this Office action.

12) The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

 a) All b) Some * c) None of:

- Certified copies of the priority documents have been received.
- Certified copies of the priority documents have been received in Application No. _____.
- Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

 a) The translation of the foreign language provisional application has been received.

15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) <input type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____	6) <input type="checkbox"/> Other: _____

DETAILED ACTION

Response to Arguments

Applicant's arguments filed 10/22/2002 have been fully considered but they are not persuasive. Applicant's argument that reference to Paterson does not disclose that "a container having a receptacle" because the receptacle (13) is not an intermediary between the container (14) and electronic device (12), has been very carefully considered but is not deemed to be persuasive. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., the receptacle is an intermediary between the container and electronic device) are not recited in the rejected claim(s).⁷ Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). According to Merriam-Webster's Collegiate Dictionary (tenth edition), the term "having" means "to hold, include, or contain as a part of whole". Paterson clearly discloses (figure 1) that the container (14) holds the receptacle (13) by clips (17). Therefore, the claimed limitation of "a container having a receptacle" has been disclosed by Paterson. Applicant's also argument that Paterson and Paine fail to disclose some of the claimed limitation, has been very carefully considered but is not deemed to be persuasive. Regarding limitation of "the" container being capable of receiving a cooling conduit", it has been held that the recitation that an element is "capable of" performing a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. In re Hutchison, 69 USPQ 138. Regarding limitation of "connecting a cooling conduit to the container", Paterson clearly discloses (figures 1 and 3) that the cooling conduit (24) is

disposed within the container (14). Regarding limitation of “forcing air or liquid through the cooling conduit”, Paterson discloses (column 4, lines 57-60) that an ambient air passes through the cooling conduit (24). Regarding limitation of “wherein the liquid coolant does not contact both the inner wall and the outer wall simultaneously”, Paterson discloses (figure 1) that the liquid coolant (20) does not contact the cylindrical outer wall (14) and the inner wall (24) simultaneously. Regarding limitation of “flow divider”, applicant is requested to see the following 103 rejection regarding claims 4 and 20.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-4,6,10-11 and 16-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Paterson (US 5,529,115) in view of Thomas O. Paine (US 3,603,382). Paterson discloses (figure 1 and 4) a heat pipe (10) comprising a container having a receptacle (13) for receiving an electronic device (12); the container having an inner wall (24) and an outer wall (14) defining a chamber that is partially filled with a liquid coolant (20) and capable of receiving a cooling conduit (24); a condenser plate (48) positioned within the container. Paterson does not disclose that a wick structure lining within an annular space between two coaxial conduits. Thomas discloses (figures 1-3 and column 4, lines 16-28) a heat pipe comprising a container having an outer wall (12) and an inner wall (10) receiving a conduit; a wick structure (14) including a first wick structure (24) lining the inside of the outer wall (12); a second wick structure (20) lining the

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inside of the inner wall (10); a communication wick structure (22) periodically connected the first and the second wick structure so that heat can be effectively transferred from the outer wall (12) to the inner wall (10) by evaporation at the outer wall and condensation at the inner wall. It would have been obvious to one having ordinary skill in the art at the time the invention was made to use Thomas's teaching in the cooling device of Paterson to effectively transfer heat from the outer wall to the inner wall by evaporation at the outer wall and condensation at the inner wall. As regard claims 4 and 20, the communication wicks (24) are symmetrical. Therefore, if the heat applied to the outer wall right below to one of the communicating wicks, the opposite communication wick is considered to be readable on the claimed limitation of flow divider.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communication from the examiner should be directed to Tho Duong whose telephone number is (703) 305-0768. The examiner can normally be reached on from 9:30-6 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Henry Bennet, can be reached on (703) 308-0101. The fax phone number for the organization where this application or proceeding is assigned is (703)308-7764.

Any inquiry of a general nature or relating to status of this application or proceeding should be directed to the receptionist whose telephone number is (703)308-0861.

Tho Duong

December 27, 2002

Henry Bennett
Supervisory Patent Examiner
Group 3700

